

Amendment in response to
August 9, 2007 Office action

Atty Dkt No.: 2001P18375US
Serial No.: 10/042,616

REMARKS

Claims 1 – 6 and 9 – 31 remain in the application and stand rejected. Claims 1 – 4, 6, 9, 10, 19 and 27 are amended herein. No new matter is added. Although this Amendment is being timely filed, the Commissioner is hereby authorized to charge any fees that may be required for this paper or credit any overpayment to Deposit Account No. 19-2179.

Claims 1 – 6 and 9 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter, ostensibly, software without a computer for execution. However, MPEP 2106 VI. B. provides in pertinent part:

For example, a claimed invention may be a combination of devices that appear to be directed to a machine and one or more steps of the functions performed by the machine. Such instances of mixed attributes, although potentially confusing as to which category of patentable subject matter the claim belongs, does not affect the analysis to be performed by USPTO personnel. Note that an apparatus claim with process steps is not classified as a "hybrid" claim; instead, it is simply an apparatus claim including functional limitations. See, e.g., *R.A.C.C. Indus. v. Stun-Tech, Inc.*, 178 F.3d 1309 (Fed. Cir. 1998) (unpublished).

Claim 1 explicitly recites a "review facility for providing a document for collaborative review by a plurality of reviewers and collecting comments from reviewers," at lines 1 – 2. While a review facility may be embodied in a single computer or a collection of computers networked together, over a single unified network or loosely, over the Internet, it is embodied in hardware providing the means for accomplishing the functions. See, e.g., page 1, line 14 – page 2, line 2. With respect to the recited preparation means, for example, the application specifically provides that in "the first primary step 102 [preparation] ... the author retrieves the item to be prepared for review, e.g., from personal storage." See, e.g., claim 2.

Further, the "means for conducting a formal review" could be an office, a conference room or an auditorium. What is required for the formal review depends upon the number of formal reviewers. Moreover, as previously noted, "ICICLE: Groupware for Code Inspection" by Brothers et al. could be considered means for conducting a formal review. Be that as it may, claim 1 is amended to delete the previously added "means for conducting a formal review," which applicants now believe rendered claim 1 overly narrow and is unnecessary for establishing

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patentability of claim 1 as set forth hereinbelow. Therefore, claims 1 – 6 and 9 are believed to be directed to patentable subject matter under 35 U.S.C. §101. Reconsideration and withdrawal of the rejection of claims 1 – 6 and 9 under 35 U.S.C. §101 is respectfully requested.

Claims 1 – 31 are rejected under 35 U.S.C. §112 as being indefinite for containing various informalities. Partially responsive thereto, claims 1 – 4, 6, 9, 10, 19 and 27 are amended herein. “Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but **should not reject claims or insist on their own preferences** if other modes of expression selected by applicants satisfy the statutory requirement.” MPEP 2173.02 (emphasis added).

Regarding definiteness of claim 10, lines 11 – 13, the Office action asks “if no action is necessary taken then why conducting a formal review?” Good question!!

That is a point of the present invention, to obviate the formal review. “As noted above, this formal review meeting 106 has much fewer issues to resolve and so, typically, is much more abbreviated from what would normally have taken place because most comments have been received and acted upon by the author prior to the meeting 106.” Page, 7, lines 5 – 8. Thus, the application provides that at the

actual code inspection meeting of step 106 [reviewers] need only to focus on comments already provided as discussion points. This greatly reduces the actual meeting time for the inspection meeting because most of the reviewers have already reviewed the code and so, most of the code does not require additional consideration. After any outstanding issues are resolved, the author completes the inspection process by correcting the identified problems and the moderator verifies the corrections. Re-publishing the corrected code is optional and may be useful when the item is subject to corrections.

Id., lines 15 – 22. So, as a result of conducting the interactive collaborative review as recited in the claims, “further action is unnecessary at the time of said formal review with respected to said particular condition and ach corresponding said comment” greatly streamlining the overall review process. Independent claims 1 and 19 are amended to include analogous recitations. Reconsideration and withdrawal of the rejection of claims 1 – 6 and 9– 31 under 35 U.S.C. §112 is respectfully requested.

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Claims 1 – 3, 6, 10, 11, 14, 16 – 21, 24, 26 – 29 and 31 are rejected under 35 U.S.C. §102(e) over U.S. Patent No. 7,007,232 to Ross et al. Claims 4, 5, 7, 12, 13, 15, 22, 23, 25 and 30 are rejected under 35 U.S.C. §103(a) over Ross et al. in view ICICLE: Groupware for Code Inspection” by Brothers et al.

Ross teaches manuscript peer review of “scholarly presentations.” *See, e.g.,* Abstract. The author “scholar” submits an article for publication peer review (col. 2, lines 55 – 60, col. 5, lines 6 – 14, line 60 – col. 6, line 7); the article is reformatted, keywords are stripped from it and peers are selected (col. 6, line 7 – col. 8, line 21); the selected peers review the publication (col. 8, line 22 – col. 9, line 47); the author responds to peer comments (col. 9, line 48 – col. 10, line 35); the editor makes a publication recommendation (col. 10, lines 36 – 67); an editorial board makes a publication decision (col. 11, lines 1 – 43); and, finally the author can revise (col. 11, line 44 et seq.). After the initial review the peers are done and nowhere in this process are the peers conducting a formal review. See the present application, e.g., page 8, lines 19 – 21 (“The formal review is scheduled after an appointed date, e.g., a scheduled end of review date, which may coincide with the end of the normal prior art review period, i.e., the end of the period allocated for the prior manual review.”). Therefore, Ross fails to teach the present invention as recited in claims 1, 10, 19 and 27.

Moreover, the dependent claims include all of the differences with the Ross, as the claims from which they depend. MPEP §2143.03 (“If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).”). Therefore, Ross fails to teach the present invention as recited by claims 2, 3, 6, 9, 11, 14, 16 – 18, 20, 21, 24, 26, 28, 29 and 31, which depend from claims 1, 10, 19 and 27. Reconsideration and withdrawal of the rejection of claims 1 – 3, 6, 9 – 11, 14, 16 – 21, 24, 26 – 29 and 31 under 35 U.S.C. §102(e) is respectfully requested.

Regarding the rejection of claims 4, 5, 12, 13, 15, 22, 23, 25 and 30 over Ross and Brothers et al., Brothers et al. provides that

Out of the several phases of code inspection, the most time consuming are:

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Comment Preparation. Code inspectors individually analyze the module to be inspected, looking for coding errors, portability problems, violation of coding standards, etc.

Code Inspection Meeting. The inspectors (and the author of the code) meet to discuss and record comments prepared.

Page 170 (emphasis original). Brothers et al. specifically provides that “we are primarily concerned with the conduct of the code inspection meeting, as the comment preparation phase does not employ groupware.” Page 171. Consequently, “the ICICLE code inspection meeting is currently intended to occur in one room with all of the inspectors facing one another close enough together for easy conversation..., just as in ordinary code inspections.” Page 173 (emphasis added). If not being held in one room, Brothers et al. teaches conducting a conference call code inspection meeting, i.e., using “ISDN for permitting ‘code inspection meetings at a distance.’ Such meetings require at a minimum voice and data links, and video may be desirable as well.” *Id.* So, Brothers et al. code inspection meeting system (whether all participants were cloistered in one room facing each other or ISDNed together in a videoconference code meeting (*Supra*)) could be considered means for/program product means for or, steps of, conducting “formal review” as recited in claims 10, 19 and 27.

However, there is nothing in either of Ross to teach or suggest conducting a formal review to “scholarly presentations;” and nothing in Brothers et al. to teach or suggest doing anything other than authoring, prior to the Brothers et al. formal review; especially nothing to teach or suggest anything that might obviate the Brothers et al. formal review. So since, as the Office action notes, “if no action is necessary taken then why conducting a formal review” (why especially for one of ordinary skill in the art?), and the combination of Ross and Brothers et al. is not obvious under 35 U.S.C. §103(a). Therefore, claims 4, 5, 7, 12, 13, 15, 22, 23, 25 and 30 are not obvious under 35 U.S.C. §103(a) over Ross and Brothers et al. Reconsideration and withdrawal of the rejection of claims 4, 5, 12, 13, 15, 22, 23, 25 and 30 under 35 U.S.C. §103(a) is respectfully requested.

The applicant thanks the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, reconsider and withdraw the rejection of claims

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1 – 6 and 9 – 31 under 35 U.S.C. §§101, 112, 102(b) and 103(a) and allow the application to issue.

As the applicants have previously noted, MPEP §706 "Rejection of Claims," subsection III, "PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED" provides in pertinent part that

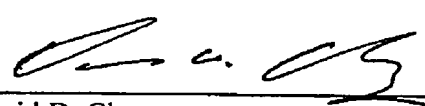
If the examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he or she may note in the Office action that certain aspects or features of the patentable invention have not been claimed and that if properly claimed such claims may be given favorable consideration.

(emphasis added). The applicants believe that the written description of the present application is quite different than, and not suggested by, any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the telephone number listed below for a telephonic or personal interview to discuss any other changes.

Respectfully submitted,

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(Date)

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